

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Prior to the Office Action, claims 1-18 were pending. Through this reply, claims 19-28 have been added. Therefore, claims 1-28 are pending. Claims 1, 7, 13 and 28 are independent.

SEPARATION OF REJECTED CLAIMS

In the Office Action, it is stated that claims 1-12 are rejected under 35 USC 103(a) as being unpatentable over Blazek et al. (USP 4,864,425) in view of Official Notice. *See Office Action, item 2.* However, all eighteen of the previously pending claims are discussed in this section of the Office Action. Therefore, it appears that the Examiner intended to reject claims 1-18 as allegedly being unpatentable over Blazek in view of Official Notice.

Regarding the Official Notice, the Examiner states “it is notoriously well-known in the audio/video recording/reproducing art to have a rewritable storage medium (such as rewritable audio disk) wherein audio data recorded thereof are being reproduced from said rewritable storage medium and being provided to an output means as specified in the present claims 1, 5, 7, 11 and 17.” *Emphasis added.* However, it is noted that the term “rewritable” only appears in claims 5, 11, and 17. None of the other rejected claims recite the

“rewritable” storage medium. Thus, if the Official Notice is applicable at all, it can only be applied to reject claims 5, 11, and 17.

As a result, claims 1-4, 6-10, 12-16, and 18 will be treated as if the claims are rejected solely based on Blazek, and claims 5, 11, and 17 will be treated as being rejected based on the combination of Blazek and the Official Notice.

REJECTION - BLAZEK

To the extent that claims 1-4, 6-10, 12-16 and 18 are rejected based on Blazek, Applicant respectfully traverses.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. See *M.P.E.P. 2142*. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. See *M.P.E.P. 2142; M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, independent claims 1 and 7 recite, in part, “wherein the compressed audio data is directly transferred to the first storage medium without being decompressed prior to being transferred.” For example, an audio data in MP3 format from the second storage medium may be transferred directly into the first storage medium without being decompressed.

Clearly, Blazek cannot be relied upon to teach or suggest this feature. Blazek clearly discloses that the internal audio source is the compact disk player 53 which plays a compact disk 54. *See column 5, lines 51-55.* However, Blazek is entirely silent regarding any such direct transfer of a compressed audio data file to the video recording tape 30.

Indeed, such a scenario is quite unlikely since videotape system, at least the system disclosed in Blazek, appears to be analog. Under this scenario, it is clear that direct transfer of a compressed audio data file is impossible. Thus, independent claims 1 and 7 are distinguishable over Blazek.

Independent claim 13 recites, in part, “wherein the audio data obtaining device is capable of obtaining audio data from both the first and second storage mediums.” *Emphasis added.* Blazek cannot be relied upon to teach or suggest at least this feature.

In the Office Action, referring to Figure 1A of Blazek, the Examiner alleged that the videotape recorder 30 is equivalent to the first storage medium as recited and the compact disk player 53 along with the compact disk 54 are equivalent to the second medium as recited. *See Office Action, item 2, second full paragraph.*

To teach or suggest the above-recited feature, it must be that the Blazek’s device is capable of obtaining audio data from the videotape recorder 30 as well from the compact disk player 53. However, Blazek states only that

the audio output from the CD player 53 may be recorded onto the tape of the videotape recorder 30. Blazek is entirely silent regarding whether audio data taken from the video tape recorder 30 may be re-recorded back onto the videotape recorder 30. It is clear that Blazek cannot be relied upon to teach or suggest at least the above-recited feature. Therefore, independent claim 13 is distinguishable over Blazek.

Claims 2-4, 6, 8-10, 12, 14-16 and 18 depend from independent claims 1, 7, and 13 directly or indirectly. Therefore, for at least due to the dependency thereon, these dependent claims are also distinguishable over Blazek.

For at least the above stated reasons, Applicant respectfully requests that the rejection of claims 1-4, 6-10, 12-16 and 18 based on Blazek be withdrawn.

REJECTION – BLAZEK, OFFICIAL NOTICE

As noted above, claims 5, 11 and 17 are treated as being rejected under 35 USC 103(a) as allegedly being unpatentable over Blazek in view of the Official Notice. Applicant respectfully traverses.

It is noted that claims 5, 11 and 17 depend from independent claims 1, 7 and 13, respectively. It has been shown above that the independent claims are distinguishable over Blazek. The Official Notice does nothing to cure at least the above-noted deficiencies of Blazek. Therefore, independent claims 1, 7 and

13 are distinguishable over the combination of Blazek and the Official Notice. For at least due to the dependency thereon, claims 5, 11 and 17 are also distinguishable over the combination of Blazek and the Official Notice. Thus, Applicant respectfully requests that the rejection of claims 5, 11 and 17 based on the combination of Blazek and the Official Notice be withdrawn.

Regarding the Official Notice itself, Applicant respectfully challenges the Notice. In the Office Action, the Examiner states “it is notoriously well known in the audio/video recording/reproducing art to have a rewritable storage medium ... wherein audio data recorded thereof are being reproduced from said rewritable storage medium and being provided to an output means as specified in the present claims.”

First, the term “output means” is not used in any of the claims. Thus, Applicant is unsure of the Examiner’s interpretation and requests a clarification thereof.

Second, Applicant is well aware that it is known to record audio data in a rewritable storage medium and reproduce the audio data contained therein. However, Applicant respectfully contests that it is well known to reproduce and to record as recited in the claims.

Third, the Examiner alleged that the motivation to combine Blazek with the Official Notice is to increase the audio recording density as suggested in the prior art. Contrary to the Examiner’s allegation, no such motivation is found

within Blazek. Therefore, the Examiner failed to meet the requirement that there must be a suggestion or motivation within the cited reference to modify the reference as proposed in the Office Action to establish *a prima facie* case of obviousness. *See MPEP 2143.01.*

Fourth, it is noted that the motivation itself is suspect. In other words, the relationship between the Examiner's suggested modification and the motivation is unclear. More specifically, it is difficult to determine that a change from a compact disk player to a rewritable storage medium would lead to an increase in audio recording density.

In summary, Applicant challenges the Official Notice and requests that the Examiner provide a valid prior art addressing all issues raised above.

NEW CLAIMS

Claims 19-28 have been added through this Reply. All new claims are believed to be distinguishable over the cited references. Applicant respectfully requests that all new claims be allowed.


CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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